REMARKS

This application has been carefully reviewed in light of the Office Action dated December 11, 2002 (Paper No. 9). Claims 1 to 66 are currently in the application, of which Claims 18 to 57 and 62 to 66 have been withdrawn from consideration by the Examiner. Claims 1, 6 to 8 and 17 are the independent claims currently under consideration. Reconsideration and further examination are respectfully requested.

The Examiner restricted Claims 18 to 57 and 62 to 66 from consideration allegedly because they are "directed to an invention that is independent or distinct from the invention originally claimed." In particular, the Examiner alleges that Claims 18 to 34, 62 and 63 are directed to an image forming apparatus having a trial copy mode with controller for prohibiting/allowing the execution of the trial copy mode; that Claims 35 to 51, 64 and 65 are directed to an image forming apparatus having a trial copy mode having first and second displays for inputting data or notifying the operator; and Claims 52 to 57 and 66 are directed to an image forming apparatus having a trial copy mode and which reads image data stored in a memory using a box function.

Applicant respectfully traverses the foregoing restriction requirement. In particular, Applicant submits that examination of all of Claims 18 to 57 and 62 to 66, in addition to the current claims under consideration, in a single application would not be an undue burden. In particular, M.P.E.P. § 808 makes clear that in order to require restriction between independent or distinct inventions, reasons for insisting upon a restriction requirement, such as undue burden, must also be shown. In the present instance, it is not believed that there would be undue burden in examining Claims 1 to 66 in a single

application, since the all such claims are not so different as would require a burden on the Examiner that is significantly beyond that of the normal burdens of examination. In particular, independent Claims 1, 6 to 8, 17, 18, 31, 32, 34, 35, 43, 44, 51, 52, 57 and 62 to 66 include at least the feature of a controlling to execute a trial image forming mode, in accordance with a mode, instruction, or condition. Accordingly, all claims are seen to be related in the same field of art, and therefore examination of all claims in the same application should not be an undue burden.

Turning to the prior art rejection, Claims 1 to 17 and 58 to 61 were rejected under 35 U.S.C. § 102(a) over U.S. Patent No. 5,987,227 (Endo). Reconsideration and withdrawal of this rejection are respectfully requested.

In this regard, Applicant respectfully points out that the foregoing § 102(a) rejection set forth at page 3 of the most recent Office Action is seen to be an exact duplicate of the § 102(a) rejection set forth in the previous Office Action dated April 24, 2002. As such, the § 102(a) rejection set forth at page 3 of the most recent Office Action is not seen to address any of the claim amendments set forth in Applicant's Amendment filed on September 24, 2002. Neither is the § 102(a) rejection seen to address how the Endo reference anticipates each and every element of the rejected claims, since the § 102(a) rejection is not seen to reference the claim language of the rejected claims. Instead, the § 102(a) rejection set forth at page 3 of the most recent Office Action is merely seen to be a narrative summary of the Examiner's view of Endo, without any cross-reference to the elements and features of the rejected claims of the present application. Accordingly, for

these reasons, the foregoing § 102(a) rejection is believed to be improper and should be withdrawn. See M.P.E.P. §§ 707.07(d), and 2131.

Applicant has amended Claims 1, 6 and 7 herein to further clarify that which Applicant regards as the invention. Support for these claims is believed to be found in Figure 9, and in the specification at page 21, lines 5 to 26, and page 27, lines 13 to 27.

Turning to specific claim language, amended independent Claim 1 is directed to an image forming apparatus which includes image input means for inputting an image data, storage means for storing the image data, image forming means for forming the image data stored in said storage means, and control means for controlling said image forming means in accordance with an image forming mode, and a plurality of processing conditions which include a first processing condition for numeric data corresponding to a number of times image forming operations are performed by said image forming means, and a second processing condition different from the first processing condition, the second processing condition corresponding to an image forming process. A function is provided that can set a trial image forming mode for an image forming process in accordance with the image forming mode, and the function halts the image forming process temporarily and enables the image forming mode to be reset after a predetermined number of image forming operations are performed based on the second processing condition and regardless of the numeric data of the first processing condition, when the trial image forming mode is effective. A numeric data for the image forming process to be performed after the trial image forming mode is released is controlled in accordance with a state of reset for the image forming mode during a halted state of the image forming process, and when the state

of reset for the image forming mode includes a reset of the second processing condition, and does not include a reset of the first processing condition, the numeric data for the image forming process to be performed after the trial image forming mode is released is set the same as the numeric data of the first processing condition before the trial image forming mode is executed. When the state of reset for the image forming mode includes said reset of the first processing condition, the numeric data for the image forming process to be performed after the trial image forming mode is released is not set the same as the numeric data of the first processing condition before the trial image forming mode is executed.

The applied art, namely Endo, is not seen to disclose or suggest the foregoing combination of features of amended independent Claim 1, particularly with respect to at least the features of controlling a numeric data for the image forming process to be performed after the trial image forming mode is released in accordance with a state of reset for the image forming mode during a halted state of the image forming process, such that when the state of reset for the image forming mode includes a reset of the second processing condition, and does not include a reset of the first processing condition, the numeric data for the image forming process to be performed after the trial image forming mode is released is set the same as the numeric data of the first processing condition before the trial image forming mode is executed, and such that when the state of reset for the image forming mode includes said reset of the first processing condition, the numeric data for the image forming process to be performed after the trial image forming mode is

released is not set the same as the numeric data of the first processing condition before the trial image forming mode is executed.

In this regard, Endo is seen to be directed to a different problem than the problem to which the present application is directed. In particular, Endo is seen to be directed to the problem of adjusting the number of copies to subsequently make depending on the whether or not a user decides to change an image forming condition. In contrast, the present invention controls the number of copies to make after a trial mode depending on whether the user decides to change an image forming condition *and depending on whether the user decides to change a the total number of copies (numeric data) to be made.* Thus, the logic for controlling the number of copies to make after the trial mode in Endo is only determinant on a change in state of one type of processing condition (i.e. an image forming condition), whereas the logic for controlling the number of copies to make after the trial mode in the present invention is determinant on a change in state of either one of *two different and separate types of processing conditions,* (i.e. an image forming condition or a numeric value corresponding to the desired total number of copies).

As discussed in Applicant's previous Amendment, Endo is seen to be directed to an image forming apparatus in which a sample set of an original document is generated for a user, and if the sample set is not acceptable to the user, the user can instruct the image forming apparatus to change how the copying is performed. (Endo, abstract; Figs. 12(a) and 12(b); column 2, lines 39 to 60; and column 3, lines 13 to 45). As further described in Endo, the number of output sets for printing after the sample set is controlled based on a change by user of an *image forming mode requiring the read-again operation.*

(Endo, column 25, lines 45 to 63). Specifically, if the user initially accepts the sample set, and therefore does not make a change to an image forming mode, the number of remaining output sets is reduced by one, but if the user does not accept the sample set by changing an image forming mode, the number of remaining output sets is set to match the number of output sets previously instructed by the user. (Endo, column 25, lines 50 to 59). However, nowhere is Endo seen to support a change in the number of remaining output sets based on a change by the user in the *numeric value which represents the desired total number of copies*, after printing of the sample set.

Accordingly, unlike the present invention, the invention of Endo is not seen to address a situation in which the user changes the desired total number of copies after a sample set is printed. Instead, Endo is only seen to subtract the number of output sets by one of no change is made to an image forming condition, or to keep the number of output sets the same if a change is made to an image forming condition. In this manner, Endo is not seen to solve the example when a user wants to change a desired total number of copies after the sample set is printed.

The Office Action cites Figure 21 and columns 25 and 26 of Endo for alleged support for the feature of Claim 1 to control the number of remaining output sets based on a change by the user in the *numeric value which represents the desired total number of copies*, after printing of the sample set. (Endo, Fig. 21; column 25, lines 45 to 67; and column 26, lines 1 to 61). However, nowhere in this portion, or any other portion of Endo, is there discussed or mentioned that a user changes the instructed number of output sets after the sample set is printed. More importantly, nowhere is Endo seen to

disclose or suggest, that the number of instructed output sets is changed based on a user's

reset value of instructed number of output sets after the printing of a sample set.

As clearly stated in Endo, the number of output sets to be printed either: (1)

is subtracted by one if the user accepts the sample set; or (2) stays the same if the user has

changed an image forming condition. (Endo, column 26, lines 25 to 37). More

importantly, Endo very clearly states that its determination for controlling the number of

output sets is based on a change in an image forming condition, such as page-number print,

which requires the read-again operation. (Endo, column 25, lines 50 to 52; and column 26,

lines 55 to 58). In contrast, the logic of the invention of amended independent Claim 1 is

determined not only on a change in an image forming condition, as in Endo, but also on a

change in a total number of copies, which is not addressed in Endo. Therefore, unlike

Endo, the claimed invention of amended independent Claim 1 takes into account a change

in either one of *two* different and separate types of processing conditions; an image forming

condition *and* a numeric value representing a desired total number of copies.

"A claim is anticipated only if each and every element as set forth in the

claim is found, either expressly or inherently described, in a single prior art reference."

M.P.E.P. § 2131, citing <u>Verdegaal Bros. v. Union Oil Co. of California</u>, 814 F.2d 628, 631,

2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). M.P.E.P. § 2131. As discussed above, not

only is Endo seen to fail the teaching of each and every element of amended independent

Claim 1, but nowhere is Endo seen to address the problem which is solved by the present

invention of amended independent Claim 1; to control the total number of copies based on

a user change to an image forming condition *and* on a user change to a desired total number of copies.

Accordingly, in view of the above, amended independent Claim 1 is believed to be in condition for allowance and such action is respectfully requested. In addition, amended independent Claims 6 and 7 are directed to an method and a storage medium which substantially incorporate the features of amended independent Claim 1, and are therefore also believed to be in condition for allowance for the same reasons discussed above with respect to amended independent Claim 1.

Lastly, the other independent claims under consideration by the Examiner, Claims 8 and 17, are directed to apparatus and method claims which include at least the feature of controlling the number of image formations after the trial image forming mode based on whether an image forming condition (second processing condition) has been changed and on whether a numeric value corresponding to the desired total number of copies (first processing condition) has been changed. Accordingly, independent Claims 8 and 17 are also believed to be in condition for allowance for the same reasons discussed above with respect to amended independent Claim 1.

The other claims under consideration are dependent from the independent claims discussed above and are therefore believed to be allowable over the applied reference for at least the same reasons. Because each dependent claim is deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merit is respectfully requested.

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

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Respectfully submitted,

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